

REMARKS

Favorable reconsideration of this application is respectfully requested in view of amendments above and the following remarks.

Status of Claims

Claims 32-48 are currently pending in the application of which claims 32, 35, 40, 43, and 46 are independent. Claims 1-32 are canceled without prejudice or disclaimer of the subject matter therein.

By virtue of the amendments above, claims 32, 34, 35, and 37-48 have been amended. Support for the amendments may be found in the specification, at least in paragraphs [0014]-[0022].

No new matter has been introduced by way of the amendments above. Entry thereof is therefore respectfully requested.

Summary of the Office Action

Claims 32, 35, 38-40, 43, and 46 were objected to because of minor informalities.

The specification was objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter.

Claims 32-48 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement.

Claims 32-48 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 32-33, 35-36, 38-41, 43-44, and 46-47 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2003/0005100 to Barnard et al. (hereinafter “Barnard”) in view of U.S. Patent No. 5,790,548 to Sistanizadeh et al. (hereinafter "Sistanizadeh"), and in further view of the applicant's admitted prior art (hereinafter "AAPA").

Claims 34, 37, 42, and 45 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Barnard in view Sistanizadeh and AAPA, in further view of what was well known in the art as applied to claims 36, 41, 44, and 47, and in further view of what was well known in the art at the time of the invention.

The rejections above are respectfully traversed for at least the reasons set forth below.

Claim Objections

Claims 32, 35, 38-40, 43, and 46 were objected to because of the word “authenticated.” In response, “authenticated” has been changed to “authenticated.” Therefore, the objection of claims 32, 35, 38-40, 43, and 46 should be withdrawn.

Specification Objection

The specification was objected to because, as asserted in the Office Action, “it is unclear how the assigned address is assigned when the node connects to the network, but at the same time the node already has the assigned address when it connects to the network.”

In response, the independent claims in the present application have been amended to recite that “wherein the particular network node has an assigned address assigned by a device in the network.” Support for this feature may be found in the specification, at least in

paragraph [0014] which states, “Network node 102 has an assigned IP address for addressing of the network node 102 by means of the transmission control protocol / Internet protocol (TCP / IP).” Thus, it is clear from the specification that the network 100 in Fig. 1 assigns an IP address to the network node 102. Therefore, the specification provides proper antecedent basis for the subject matter now recited in the claims. Withdrawal of the objection to the specification is therefore respectfully requested.

Claim Rejection Under 35 U.S.C. §112

Claims 32-48 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. The claims have been amended to recite “wherein the particular network node has an assigned address assigned by a device in the network.” In view of the amendments above to the claims, it is believed that the written description of the present application provide proper support for the subject matter recited in the claims. Withdrawal of the rejection of claims 32-48 under 35 U.S.C. §112, first paragraph is therefore respectfully requested.

Claims 32-48 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. The claims have been amended to recite “wherein the particular network node has an assigned address assigned by a device in the network.” In view of the amendments above to the claims, it is believed that claims 32-48 are now clear and definite. Withdrawal of the rejection of claims 32-48 under 35 U.S.C. §112, second paragraph is therefore respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007):

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or

to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness.”

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render the claims obvious and, thus, the claims are distinguishable over the cited reference(s).

- **Claims 32-33, 35-36, 38-41, 43-44, and 46-47:**

Claims 32-33, 35-36, 38-41, 43-44, and 46-47 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Barnard in view of Sistanizadeh in further view of AAPA. This rejection is respectfully traversed for at least the following reasons.

Amended independent claim 32 recites,

“wherein the particular network node has an assigned address assigned by a device in the network.”

In the rejection of claim 32, the Office Action asserts that the MAC address of the printer, as disclosed in paragraph [0074] of Barnard, is the “assigned address” recited in claim 32 (See *Office Action*, page 7). However, that assertion is respectfully traversed because the MAC address is not an assigned address assigned by the network. A MAC address is a permanent unique identifier of a network card given at the time of manufacture of the network card, and it is not later assignable. A subsequent sentence from the same paragraph [0074] makes clear that an assigned address is different than a MAC address

stating, “[t]he MAC address and the assigned IP address are provided to” Therefore, the MAC address in Barnard is not the “assigned address” of a particular network node, as recited in claim 32.

Claim 32 also recites,

the discovery procedure for the particular network node including polling other nodes in the network to determine a network topography, the polled network topography including at least some of the other nodes to which the particular network node is connected, and the configuration of the particular network node.

Claim 32 also describes that the discovery procedure is in response to the access request from the node establishing a connection to the network. Barnard and Sistanizadeh fail to teach or suggest these features. In the rejection of claim 32, the Office Action asserts that the features recited above are disclosed in paragraph [0077], lines 12-27 of Barnard (*Office Action*, page 8). However, paragraph [0077], lines 12-27 discloses polling of nodes one at a time. However, paragraph [0077], lines 12-27 does not disclose polling a network topology, but rather, only discloses sending an SNMP information request message over network 10 to the printing device. Thus, Barnard fails to teach or suggest the polling features recited above in claim 32.

The Office Action also admits that Barnard and Sistanizadeh fail to teach or suggest polling other nodes in a network to determine a network topology (See *Office Action*, page 9). The Office Action then relies on AAPA described in the background of the Applicants' specification to teach this claimed feature. The background of the Applicants' specification discloses scheduled polling of the network that is typically performed at night when the network load is low. The background in paragraph 6 then describes the disadvantages of the scheduled polling. Paragraph 6 states,

A disadvantage of scheduled discovery which is performed by the NNM product is that the discovery procedure can negatively affect network performance when the discovery procedure is carried out. This is why the discovery schedule is typically set such that the discovery procedure is carried out when the network load is low, i.e., during the night. However, performing the discovery at predetermined time intervals has the disadvantage that network nodes which are connected to the network only temporarily can be missed by the discovery. In particular this applies to portable computers, such as lap top computers which are frequently connected and disconnected to the network by means of a docking station.

Thus, the APPA being relied upon by the Office Action discloses scheduled discovery, and the combination of the APPA with Barnard in view of Sistanizadeh would result in the system of Barnard performing scheduled discovery. Barnard in view of the APPA fails to teach or suggest the discovery procedure is initiated in response to the initial request from the node establishing a connection to the network, which is claimed and disclosed in the Applicants specification. Furthermore, it should be noted that this claimed feature overcomes the downfalls of the AAPA, because the claimed discovery, which is initiated in response to the initial request from the node establishing a connection to the network, captures devices that are temporarily connected to the network and has less impact on network performance.

Note that the arguments above were presented in the previous Response. However, the Examiner fails to respond to those arguments in the Office Action.

For the foregoing reasons, Barnard, Sistanizadeh and AAPA, singularly and in combination, fail to teach or suggest the aforementioned features of claim 32.

PATENT

Atty Docket No.: 200309655-2
App. Ser. No.: 10/698,016

Independent claims 35, 40, 43 and 46 recite features similar to the features of claim 32 described above which are not taught by Barnard, Sistanizadeh or AAPA. Thus, claims 32-33, 35-36, 38-41, 43-44, and 46-47 are believed to be allowable.

- **Claims 34, 37, 43, and 45:**

Claims 34, 37, 43, and 45 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Barnard in view of Sistanizadeh and AAPA, and in further view of Official Notice. Claims 34, 37, 43, and 45 are believed to be allowable at least for the reasons their respective independent claims are believed to be allowable.

PATENT

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Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below.

Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

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